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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91223528
Party	Defendant Multisorb Technologies, Inc.
Correspondence Address	RHETT V BARNEY LEE & HAYES PLLC 601 W RIVERSIDE AVE, STE 1400 SPOKANE, WA 99201 UNITED STATES rhettb@leehayes.com, chris@leehayes.com, amandas@leehayes.com, lhilit-docket@leehayes.com, trademarks@leehayes.com , shellyg@leehayes.com
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Date	12/29/2015
Attachments	12b6 Response Final.pdf(3326573 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CLARIANT CORPORATION,

Opposer,

v.

MULTISORB TECHNOLOGIES, INC.,

Applicant.

Opposition No. 91223528

Application Serial No. 86/569,259

Mark: DESIPAX

APPLICANT’S RESPONSE TO OPPOSER’S MOTION TO DISMISS

MULTISORB’S COUNTERCLAIM

Opposer Clariant Corporation (“Opposer” or “Clariant”) filed a Motion to Dismiss alleging that Multisorb Technologies, Inc. (“Multisorb” or “Applicant”) failed to provide fair notice of its theory of abandonment. In its Counterclaim, Multisorb alleged that Clariant abandoned the mark by discontinuing use with an intent not to resume such use. While these are the elements of abandonment, they are also the two facts that Multisorb must prove to prevail on its counterclaim. As in most cases, the details are known only to Clariant. Multisorb knows that Clariant discontinued use, which Multisorb alleged, and believes that Clariant had an intent not to resume use, which Multisorb also alleged. Clariant, not Multisorb knows the details. Contrary to Clariant’s allegations, and in an attempt to resolve the dispute early on, Multisorb gave Clariant an opportunity, as early as September 11, 2015, to provide evidence of continuous use. Multisorb even offered, if the evidence was sufficient, to withdraw its application. Clariant provided scant evidence of use of the DESI PAK mark in commerce and wholly insufficient evidence to show continuous use. (“Barney Decl.” at ¶ 5; *see also* Ex. 1 to Barney Decl.). Multisorb contacted Clariant again and advised that even evidence of a sale a year might be sufficient. *Id.* Clariant did

not respond. *Id.* Multisorb proceeded with its counterclaim. Nonetheless, Multisorb's pleading provided factual support for its theory of abandonment in the counterclaim itself and also incorporated its denials of Opposer's allegation of continuous use. Opposer now attempts to argue it did not receive notice of Multisorb's intent to counterclaim for abandonment, and instead attempts to improperly and prematurely transform its motion to dismiss into a motion for summary judgment by relying on evidence outside the pleadings. Even if considered, this evidence is insufficient to show continuous use. Multisorb requests that the Board exclude these references and deny Opposer's Motion to Dismiss based on the properly pled counterclaims, or, in the alternative, grant Multisorb leave to amend its pleading under Federal Rule of Civil Procedure 15(a)(2) and TBMP 503.03.

ARGUMENT

A. Standard of Review

In order to withstand a motion to dismiss for failure to state a claim under Rule 12(b)(6), an applicant need only allege such facts as would, if proved, establish that (1) the applicant has standing to maintain the proceeding,¹ and (2) a valid ground exists for cancelling the registration. TBMP 503.02. The applicant is not required to set forth detailed factual allegations; “[r]ather, a plaintiff need only allege ‘enough factual matter . . . to suggest that [a claim is plausible]’ and ‘raise a right to relief above the speculative level.’” *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346 (Fed. Cir. 2010). The Board must examine the pleading in its entirety, liberally construing the allegations therein in the light most favorable to applicant and accepting all allegations as true, to determine whether the allegations, if proved, would entitle the applicant to

¹ Pursuant to the rules, Multisorb as counterclaimant is not required to address standing, as standing is implicit in Multisorb's position as counterclaimant.

the relief sought. *Fair Indigo*, 2007 WL 4162785 at *2; *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 1161 (Fed. Cir. 1993); *see also* TBMP 503.02.

The elements of each claim should be stated concisely and directly, and include enough detail to give the defendant fair notice. Fed. R. Civ. P. 8(d)(1); *see also Harsco Corp. v. Elec. Sciences Inc.*, 9 U.S.P.Q.2d 1570, 1571 (because the function of pleadings is to give fair notice of a claim, a party is allowed reasonable latitude in its statement of its claims). Based on the simplified notice function prescribed by the Federal Rules of Civil Procedure, the Board must liberally construe the allegations so as to do substantial justice. *Scotch Whisky Ass’n v. U.S. Distilled Prods. Co.*, 952 F.2d 1317, 1319 (Fed. Cir. 1991). The purpose of a Rule 12(b)(6) motion is to challenge “the legal theory of the complaint, not the sufficiency of any evidence that might be adduced.” *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, *supra* at 26 U.S.P.Q.2d 1041.

B. Multisorb Adequately Pled Its Counterclaim for Opposer’s Abandonment of the DESI PAK Mark.

An applicant can adequately plead a ground for cancellation by alleging abandonment of a mark as to particular goods through nonuse with no intent to resume use. *Dak Indus. Inc. v. Daiichi Kosho Co.*, 1995 WL 454108 at *4, 35 U.S.P.Q.2d 1434 (T.T.A.B. 1995) (citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185 (C.C.P.A. 1982)); *see also McCarthy on Trademarks* 20:44 n.7. The plaintiff must plead ultimate facts pertaining to the alleged abandonment, thus providing fair notice to the defendant. *Dragon Bleu (SARL) v. VENM, LLC*, 2014 WL 7206399 at * 6, 112 U.S.P.Q.2d 1925, 1930 (T.T.A.B. 2014). Although Trademark Act Section 45 permits the Board to accept proof of non-use for three consecutive years as a prima facie case of abandonment, the plaintiff “need not allege a specific time frame in order to plead a sufficient claim of abandonment.” *Pizza Donini, Inc. v. Pizza Donini, Inc.*, 2002

WL 31173412 at *3 (T.T.A.B. 2002). A sufficient claim of abandonment may be made by an allegation that use has been discontinued with no intent to resume such use. *Id.*

Multisorb adequately pled its claim for abandonment by alleging nonuse with an intent not to resume use for the specific goods referenced. (Applicant's Answer and Counterclaim. at ¶¶ 23-25.) Specifically, Multisorb alleged that "Opposer has abandoned the DESI PAK mark *by* discontinuing use of the mark for each of the goods listed therein, with an intention not to resume use" *Id.* (emphasis added). Multisorb also listed the goods that Opposer abandoned. (*Id.* at ¶ 24-25.) Thus, Multisorb made the following factual allegations: (1) Opposer discontinued use of the mark, (2) with respect to the specific goods listed, and that (3) Opposer intended not to resume use. These ultimate facts led to Multisorb's legal conclusion that Opposer abandoned the DESI PAK mark and, as a result, Multisorb requested cancellation. The plain language of the pleading demonstrates that Multisorb provided fair notice to Opposer.

Furthermore, in Multisorb's Answer to Opposer's Notice of Opposition, Multisorb denied each allegation of continuous use and expressly incorporated these denials into its Counterclaim. (*Id.* at ¶¶ 7-10, 23.) Specifically, Multisorb denied that Opposer continuously used the DESI PAK mark since December 13, 1983, (*Id.* at ¶ 7), invested significant amounts of resources in the marketing and promotion of the DESI PAK mark, (*Id.* at ¶ 8), established association with its Mark due to its extensive use and investment, (*Id.* at ¶ 9), and that it established goodwill as a result of its extensive use and investment, (*Id.* at ¶ 10). Each of these allegations contain unproven facts bearing on Opposer's use of the DESI PAK mark, and Multisorb expressly incorporated its denials into its counterclaim, supplying additional foundation for its claim for abandonment.

Taken together, Multisorb satisfied its burden of alleging abandonment of the mark as to particular goods through nonuse with intent not to resume use. Liberally construing these facts and accepting the allegations as true, the Board can determine that Multisorb is entitled to the relief sought if subsequently proven. Thus, Opposer received adequate notice of the claim asserted based on the plain terms of the pleading.

C. Multisorb Provided Further Notice to Opposer Prior to Asserting its Counterclaim for Abandonment.

Prior to filing its Counterclaim, counsel for Multisorb informed Opposer of its claim of abandonment, thus providing fair notice as of September 11, 2015. (Demulclation of Rhett V. Barney re Applicant's Resp. to Opposer's Mot. To Dismiss Multisorb's Countercl. ("Barney Decl." at ¶ 5; *see also* Ex. 1 to Barney Decl.) In doing so, counsel for Multisorb invited Opposer to supply evidence of its continuous use from 2005 to 2015 to rebut its claim, but Opposer failed to supply evidence of use in commerce. (*Id.* at ¶¶ 5-6.) Instead of demonstrating actual sales of products with the DESI PAK mark, Clariant, through its counsel of record, provided twelve web printouts from the Internet Archive WayBack Machine that show that at some times in the past advertising material for the DESI PAK mark appeared on the world wide web, but with no means for ordering or purchasing the products. Further, the images provided show the DESI PAK products being advertised by a company called Sud-Chemie, not Clariant. See Ex. 1 to Barney Decl. The parties then stipulated to filing an extension based on Clariant's offer to provide additional evidence that met the requirements for continuous use, but despite several follow up communications again requesting the information, Opposer ultimately failed to provide any additional evidence of use in commerce. (*Id.* at 7-8.) Based on the dearth of evidence supporting Opposer's alleged continuous use of the DESI PAK mark, Multisorb filed its counterclaim for cancellation of the abandoned mark.

Opposer's claim that it lacks fair notice of Multisorb's theory of abandonment is disingenuous. As shown in the concurrently filed Declaration of Rhett Barney, Opposer has been well informed of Multisorb's theory of abandonment and had an opportunity to rebut the allegation prior to filing. (*Id.* at ¶¶ 5-8; *see also* Ex. 1 to Barney Decl.)

Furthermore, the cases relied upon by Clariant are distinguishable and inapplicable. In *GMA Accessories, Inc. v. Dorfman-Pacific Co.*, Opp. No. 91196926 (TTAB 2013) the issue before the Board was likelihood of confusion, not abandonment. While at one point in time the parties in that matter were disputing the issue of abandonment it was not ruled upon by the Board because the nearly all of the issues in the TTAB proceeding had been resolved in a related district court proceeding. Similarly, *Otto Int'l Inc. v. Otto Kern GMBH*, 83 U.S.P.Q.2d 1861 (T.T.A.B. 2007) is not a case that deals primarily with the issue of abandonment. In *Otto*, the petitioner made a claim of Section 2(d) likelihood of confusion, and then realizing that Section 2(d) was inapplicable, amended its Notice of Cancellation to state that "[u]pon information and belief, Registrant has abandoned use of Registration No. 2432890" for the goods listed in the registration. Those were the only factual allegations made with regards to abandonment, and the Board noted that "the allegation that respondent has "abandoned use" makes no claim that respondent has failed to use its mark for a period of greater than three years, nor does it make the claim that respondent has discontinued use of its mark with an intent not to resume use." *Otto Int'l*, 83 U.S.P.Q. 2d at 1866. In this matter, Multisorb has alleged both, and thus meets the expectations of the Board in *Otto*.

Finally, Clariant relies heavily on a recent unpublished decision from the Southern District of New York, *Highline Capital Mgmt., LLC v. High Line Venture Partners, L.P.*, No. 15-CV-660 (VEC), slip op. at 6 (S.D.N.Y. Oct. 1, 2015), which is also inapplicable and

distinguishable. In *Highline*, the plaintiff alleged abandonment of the HIGHLINE mark and submitted specimens used by the defendant at the USPTO for purposes of its Section 8 and 15 filings for Continued Use and Incontestability, claiming that the specimens were insufficient to demonstrate use of the mark HIGHLINE, since the word “highline” was also used in connection with the words “Capital Manage” (i.e. “Highline Capital Management”). The district court found that such use did in fact constitute use of the HIGHLINE mark in connection with the services claimed in the defendant’s registration, and that as a result, Plaintiff’s claim of abandonment was facially implausible. Here, Multisorb did not rely on any evidence outside the record in its counterclaim for abandonment, and instead plead with sufficient clarity and specificity grounds for cancellation on the basis of abandonment, nothing more nothing less.

Highline is also distinguishable because of the nature of the HIGHLINE trademark. HIGHLINE was a service mark used in connection with “the financial services industry in the nature of investment fund management”, and as such has different requirements for demonstrating use in commerce. Compare TMEP 904 to TMEP 1301.04. The information that Clariant provided to Multisorb before the filing of Multisorb’s Answer and counterclaims simply do not meet the requirement for use in commerce for goods. *See* Barney Declaration.

D. Clariant’s Reliance on Outside Evidence Improperly Transforms its Motion to Dismiss into a Premature Motion for Summary Judgment.

On a motion to dismiss for failure to state a claim upon which relief can be granted, if matters outside the pleadings are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment. TBMP 503.4; *Compagnie Gervais Danone v. Precision Formulations, LLC*, 2009 WL 34747 at *4, 89 U.S.P.Q.2d 1251, 1255-56 (T.T.A.B. 2009). In addition, under Trademark Rule 2.127(e)(1), a party may not file a motion for summary judgment until the party has made its initial disclosures. Because Opposer has relied

on outside evidence, the Board must either deny the motion as premature or exclude these references. In the alternative, if the Board decides to treat Clariant's motion as a motion for Summary Judgment and allow and consider it, then judgment should be entered in Multisorb's favor because the evidence of use of the DESI PAK mark in the record is insufficient to show continuous use of the DESI PAK mark, indeed, there is no evidence of any use of the DESI PAK mark.

In its Motion to Dismiss, Opposer questioned why Multisorb did not challenge evidence of its continued use of the DESI PAK mark and then references evidence outside the pleadings. (Mot. to Dismiss at pgs. 1-2, 5.) Opposer expressly references previous Section 8 Declarations of Use and advertisements on its company website in an attempt to disprove Multisorb's claim for abandonment, references outside the pleadings, which constitute a premature attempt to file a motion for summary judgment on the merits of the counterclaim. Thus, Multisorb requests that the Board either deny the motion as premature, enter judgment for Multisorb, or exclude these references.

Nonetheless, the evidence referred to and relied upon by Opposer is insufficient to rebut Multisorb's prima facie case of abandonment based on non-use for at least a ten-year period. First, the mere advertising of goods or services does not constitute bona fide use of a mark under 15 U.S.C. § 1127. TMEP 904.03(i) (stating that "a web page that merely provides information about the goods, but does not provide a means of ordering them, is viewed as promotional material, which is not acceptable to show trademark use on goods"); *see also Couture v. Playdom, Inc.*, 778 F.3d 1379, 1381 (Fed. Cir. 2015). Opposer's website simply advertises the desiccant bags and provides contact information, but there is no open and notorious public offering of the goods, nor is there a means for ordering the identified goods.

This is particularly true when it appears from the evidence relied upon by Clariant that from 2005 until at least 2013, the mark was never used by Clariant, and was instead used by a company called Sud-Chemie.

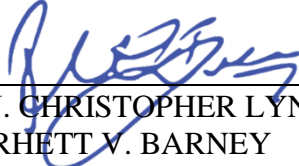
As a result, Opposer has not provided any evidence of sales of goods bearing the DESI PAK mark. Second, Multisorb can establish abandonment and cancel the DESI PAK registration by proving non-use with no intent to resume over any three-year period. *See AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1550 (11th Cir. 1986); *Mission Dry Corp. v. Seven-Up Co.*, 193 F.2d 201, 203-204 (C.C.P.A. 1951). Thus, even if the 2015 Declaration of Use was accepted by the USPTO, there is still no evidence of any bona fide use of the mark from March, 2005 through October, 2015. Therefore, Opposer has not rebutted the presumption of non-use.

E. Conclusion

For the foregoing reasons, Applicant Multisorb requests that the Board deny Opposer's Motion to Dismiss Multisorb's Counterclaim or, enter summary judgment for Multisorb on the counterclaim, or in the alternative, grant Multisorb leave to amend its counterclaim pursuant to Federal Rule of Civil Procedure 15 (a)(2).

Dated: December 29, 2015

Respectfully Submitted,



J. CHRISTOPHER LYNCH

RHETT V. BARNEY

Lee & Hayes, PLLC

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chris@leehayes.com

rhettb@leehayes.com

Attorneys for Applicant, Multisorb Technologies, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on this 29th day of December, 2015, the Applicant's Response To Opposer's Motion To Dismiss Multisorb's Counterclaim was served upon Applicant's attorneys of record by emailing the same as follows:

Sean M. Sullivan
Lee Sullivan Shea & Smith LLP
224 N Desplaines St Ste 250
Chicago, IL 60661
UNITED STATES
sullivan@ls3ip.com, smith@ls3ip.com

Dated this 29th day of December, 2015.

Respectfully Submitted,



J. CHRISTOPHER LYNCH
RHETT V. BARNEY
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Attorneys for Opposer, Multisorb Technologies, Inc.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CLARIANT CORPORATION,

Opposer,

v.

MULTISORB TECHNOLOGIES, INC.,

Applicant.

Opposition No. 91223528

Application Serial No. 86/569,259

Mark: DESIPAX

**DECLARATION OF RHETT V. BARNEY RE APPLICANT’S RESPONSE TO
OPPOSER’S MOTION TO DISMISS MULTISORB’S COUNTERCLAIM**

I, Rhett V. Barney, do hereby state and declare the following:

1. I am over the age of eighteen (18) and competent to testify with regard to the matters contained herein, based on personal knowledge, files, and research relating to this proceeding.

2. I am one of the attorneys for Multisorb Technologies, Inc. (“Multisorb”) in the above-captioned matter.

3. After Opposer Clariant Corporation (“Clariant”) filed its Opposition on August 27, 2015, I contacted the attorney for Clariant, Sean Sullivan, on September 9, 2015.

4. Attached as Exhibit A is a true and correct copy of an email string between Sean Sullivan and myself, dated September 9, 2015 through October 6, 2015.

5. Mr. Sullivan and I then held a conference call on September 11, 2015, which is reflected in Exhibit A. During the conference call, I explained Multisorb’s position with respect to Clariant’s alleged use of the DESI PAK mark. I informed Mr. Sullivan that Multisorb would withdraw its trademark application for the DESIPAX trademark application if Clariant could provide evidence of continuous use in commerce of the DESI PAK mark, and I invited Clariant

to supply that evidence. Mr. Sullivan offered to provide evidence of Clariant's continuous use of the DESI PAK mark.

6. On October 1, 2015, Mr. Sullivan sent me a correspondence and provided evidence that Clariant believed demonstrated continuous use of the DESI PAK mark, i.e. multiple screen shots and printouts from the Internet Archive WayBack Machine for the dates 2005 to 2015. Attached as Exhibit B is a true and correct copy of this correspondence. That same day, I responded to Mr. Sullivan, indicating Multisorb's position that the evidence provided was insufficient to establish continuous use of the DESI PAK mark because the evidence provided by Clariant only demonstrated advertising of the mark, but no actual use in commerce. *See id.* I informed Mr. Sullivan that evidence of one sale a year would be sufficient evidence.

7. Mr. Sullivan and I continued to discuss the matter, and on October 6, 2015, Mr. Sullivan agreed to supplement Clariant's previous production. The parties stipulated to a 30-day extension of time for Multisorb to respond to the Notice of Cancellation in order for Clariant to supplement the evidence. *See id.*

8. Multisorb has not received any supplement or any other evidence of Clariant's continuous use of the DESI PAK mark.

///

///

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

DATED THIS 29th day of December, 2015, at Spokane, Washington.

A handwritten signature in blue ink, appearing to read "Rhett V. Barney", is written over a horizontal line.

RHETT V. BARNEY
Lee & Hayes, PLLC
601 W. Riverside Avenue, Suite 1400
Spokane, WA 99201
Telephone: (509) 944-4792
Fax: (509) 323-8979
rhettb@leehayes.com

Attorney for Applicant, Multisorb Technologies, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on this 29th day of December, 2015, the foregoing Declaration of Rhett V. Barney re Applicant's Response to Opposer's Motion to Dismiss Multisorb's Counterclaim was served upon Applicant's attorneys of record by emailing the same as follows:

Sean M. Sullivan
J. Dan Smith
Lee Sullivan Shea & Smith LLP
224 N. Desplaines St., Ste. 250
Chicago, IL 60661
sullivan@ls3ip.com, smith@ls3ip.com

Dated this 29th day of December, 2015.

Respectfully Submitted,



J. CHRISTOPHER LYNCH
RHETT V. BARNEY
Lee & Hayes, PLLC
601 W. Riverside Avenue, Suite 1400
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chris@leehayes.com
rhettb@leehayes.com

Attorneys for Opposer, Multisorb Technologies, Inc.

EXHIBIT A

From: Sean Sullivan <sullivan@ls3ip.com>
Sent: Tuesday, October 6, 2015 6:51 PM
To: Rhett Barney
Cc: Chris Lynch; Amanda Sasser; Dan Smith
Subject: Re: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

Rhett:

We are good with service by email. No need to send any mail copies.

Best,
Sean

Sent from my iPhone

On Oct 6, 2015, at 8:03 PM, Rhett Barney <RhettB@Leehayes.com> wrote:

Sean,

I appreciate your consent, and I apologize for waiting until the end of the day to get back to you. I was not able to get in contact with my client today, so that is what took so long. We had the Answer prepared and were planning to file it today, but because I was not able to contact the client to see if they had a preference, I decided to take you up on your offer of a 30-day extension. That said, if I am able to connect with the client tomorrow and am instructed to file the Answer, then I'll let you know of my intent to do that.

A couple of points of business:

- ? By way of Service, attached is the consent motion confirmation of filing. We haven't agreed yet to service by email as required by the rules. So, please let me know if you agree to service by email. If not, I can put this confirmation in the mail for you tomorrow.
- ? We understand your desire to enter into a confidentiality agreement, and we are willing to enter into one. I'll check with Multisorb on the format they would prefer, though it seems to me that an invoice showing at least one sale for each year of claimed use would be sufficient. Again, I'll confirm that with Multisorb.

Best regards,
Rhett

Rhett Barney
rhettb@leehayes.com

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601 West Riverside Avenue, Suite 1400 | Spokane, Washington 99201

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From: Sean Sullivan [<mailto:sullivan@ls3ip.com>]
Sent: Tuesday, October 06, 2015 9:55 AM
To: Rhett Barney <RhettB@Leehayes.com>
Cc: Chris Lynch <chris@leehayes.com>; Amanda Sasser <AmandaS@LeeHayes.com>; Dan Smith <smith@ls3ip.com>
Subject: Re: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

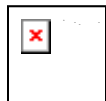
Rhett:

We are in the process of checking into your request for sales information. Unfortunately, we will not be able to provide any such information by today. Thus, if you need a 30-day extension of time for your answer to the Opposition, you have Clariant's consent.

Before producing any limited confidential sales information, we would of course have to work out a confidentiality agreement. Redacting will only take us so far. In addition, please let us know what format and information will satisfy your client with respect to our sales for DESI PAK. Obviously, we do not want to produce confidential sales information to a competitor, only to have Multisorb balk at the information and question its legitimacy.

Best regards,
Sean

Sean M. Sullivan



Lee Sullivan Shea & Smith LLP 312.754.9607 (O)
224 N Desplaines St Ste 250 708.790.1865 (M)
Chicago, Illinois 60661 sullivan@ls3ip.com

From: Rhett Barney
Date: Friday, October 2, 2015 at 12:26 PM
To: "Sean M. Sullivan"
Cc: Chris Lynch, Amanda Sasser, Dan Smith
Subject: RE: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

Sean,

Thanks for your email. I understand your position and reluctance, but what Clariant is asking of Multisorb is to cease using a mark that it has been using for nearly 20 years. It's not as if this is an ITU where no real investment has been made. Multisorb is very invested in DESIPAX, so to simply recommend to my client that it abandon its mark based solely on Wayback Machine screengrabs would be irresponsible.

We are not asking that Clariant divulge sensitive information before the parties have entered into a protective order, but we are asking for real evidence of continuous use in commerce. If that means redacting much of the information, then that is fine. If we need to work something else out, then that is fine as well.

If there is not something that you will be able to provide us by Monday, please let me know so that I can discuss with my client on how best to proceed.

Best,
Rhett

Rhett Barney
rhettb@leehayes.com

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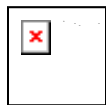
From: Sean Sullivan [<mailto:sullivan@ls3ip.com>]
Sent: Thursday, October 01, 2015 4:45 PM
To: Rhett Barney <RhettB@Leehayes.com>
Cc: Chris Lynch <chris@leehayes.com>; Amanda Sasser <AmandaS@LeeHayes.com>; Dan Smith <smith@ls3ip.com>
Subject: Re: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

Rhett:

The advertisements clearly show use of Clariant's mark on the goods themselves, and provide evidence that the goods have been, and continue to be, a relevant part of Clariant's product offering for more than the past decade. The fact that Clariant is selling this product is obvious from the advertising that we sent you. Indeed, why would Clariant publicly advertise its product for more than ten years and not be selling it? I am reluctant to ask Clariant to provide confidential financial information to a competitor like Multisorb before discovery is open and the parties have agreed upon a protective order. Why does Multisorb doubt that Clariant has been, and still is, selling this publicly advertised product?

Best regards,
Sean

Sean M. Sullivan



Lee Sullivan Shea & Smith LLP 312.754.9607 (O)
224 N Desplaines St Ste 250 708.790.1865 (M)
Chicago, Illinois 60661 sullivan@ls3ip.com

From: Rhett Barney
Date: Thursday, October 1, 2015 at 5:51 PM
To: "Sean M. Sullivan"
Cc: Chris Lynch, Amanda Sasser, Dan Smith
Subject: RE: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

Sean,

Thank you for your email and attachments. My apologies if I missed something, but it looks like all that you provided us were waybackmachine screengrabs of advertising materials. As you know, advertising materials are insufficient to demonstrate use of the mark in interstate commerce. Can you provide us with something more, something that shows that Clariant is actually selling these products, and that Clariant has continued to sell them since '85?

Best,
Rhett

Rhett Barney
rhettb@leehayes.com

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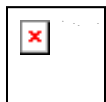
From: Sean Sullivan [<mailto:sullivan@ls3ip.com>]
Sent: Thursday, October 01, 2015 11:31 AM
To: Rhett Barney <RhettB@Leehayes.com>
Cc: Chris Lynch <chris@leehayes.com>; Amanda Sasser <AmandaS@LeeHayes.com>; Dan Smith <smith@ls3ip.com>
Subject: Re: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

Rhett:

Please see the attached correspondence and evidence of use. Let me know if you have any troubles opening the ZIP file.

Best regards,
Sean

Sean M. Sullivan



Lee Sullivan Shea & Smith LLP 312.754.9607 (O)
224 N Desplaines St Ste 250 708.790.1865 (M)
Chicago, Illinois 60661 sullivan@ls3ip.com

From: "Sean M. Sullivan"
Date: Wednesday, September 30, 2015 at 9:28 AM
To: Rhett Barney
Cc: Chris Lynch, Amanda Sasser, Dan Smith
Subject: Re: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

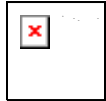
Rhett:

I should have a response for you by the end of the week.

Thanks,

Sean

Sean M. Sullivan



Lee Sullivan Shea & Smith LLP 312.754.9607 (O)
224 N Desplaines St Ste 250 708.790.1865 (M)
Chicago, Illinois 60661 sullivan@ls3ip.com

From: Rhett Barney
Date: Tuesday, September 29, 2015 at 2:22 PM
To: "Sean M. Sullivan"
Cc: Chris Lynch, Amanda Sasser
Subject: RE: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

Hello Sean,

Thanks for your time on the phone earlier this month. I have not heard back from you yet regarding your client's continuous use, and I am hoping that you can provide us with that information within the next several days. As you know, the deadline to file an answer is October 6.

As for our use, the packaging specimen used by our client is, as far as I can tell, how the mark is used by Multisorb.

I look forward to hearing from you.

Best regards,
Rhett

Rhett Barney
rhettb@leehayes.com

P 509.944.4642 | **F** 509.323.8979
601 West Riverside Avenue, Suite 1400 | Spokane, Washington 99201

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From: Sean Sullivan [<mailto:sullivan@ls3ip.com>]
Sent: Friday, September 11, 2015 6:02 AM
To: Rhett Barney <RhettB@Leehayes.com>
Cc: Chris Lynch <chris@leehayes.com>; Amanda Sasser <AmandaS@LeeHayes.com>
Subject: Re: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

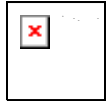
Rhett:

I am not in the office today, so can we use the following dial-in number for our call today:

Dial: (605) 562-3180
Participant Code: 820 010 682

Thanks,
Sean

Sean M. Sullivan



Lee Sullivan Shea & Smith
224 N Desplaines St Ste 250
Chicago, Illinois 60661

312.754.9607 (O)
708.790.1865 (M)
sullivan@ls3ip.com

From: Rhett Barney
Date: Wednesday, September 9, 2015 at 5:46 PM
To: Sean Sullivan
Cc: Chris Lynch, Amanda Sasser
Subject: RE: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

I'll call you at the number below, thank you.

Best,
Rhett

Rhett Barney
rhettb@leehayes.com

P 509.944.4642 | **F** 509.323.8979
601 West Riverside Avenue, Suite 1400 | Spokane, Washington 99201

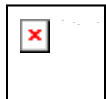
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From: Sean Sullivan [<mailto:sullivan@ls3ip.com>]
Sent: Wednesday, September 09, 2015 3:31 PM
To: Rhett Barney <RhettB@Leehayes.com>
Cc: Chris Lynch <chris@leehayes.com>; Amanda Sasser <AmandaS@LeeHayes.com>
Subject: Re: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

That should work. Do you just want to call me at my office number below, or is there a call-in number?

Sean M. Sullivan



Lee Sullivan Shea & Smith
224 N Desplaines St Ste 250
Chicago, Illinois 60661

312.754.9607 (O)
708.790.1865 (M)
sullivan@ls3ip.com

From: Rhett Barney
Date: Wednesday, September 9, 2015 at 5:08 PM
To: "Sean M. Sullivan"
Cc: Chris Lynch, Amanda Sasser
Subject: RE: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

How about Friday at 1pm PT, 3pm CT?

Thanks,
Rhett

Rhett Barney
rhettb@leehayes.com

P 509.944.4642 | **F** 509.323.8979
601 West Riverside Avenue, Suite 1400 | Spokane, Washington 99201

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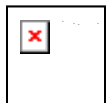
From: Sean Sullivan [<mailto:sullivan@ls3ip.com>]
Sent: Wednesday, September 09, 2015 2:49 PM
To: Rhett Barney <RhettB@Leehayes.com>
Cc: Chris Lynch <chris@leehayes.com>; Amanda Sasser <AmandaS@LeeHayes.com>
Subject: Re: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

Hi Rhett:

This Friday works for me, but I am out Monday.

Best,
Sean

Sean M. Sullivan



Lee Sullivan Shea & Smith 312.754.9607 (O)
224 N Desplaines St Ste 250 708.790.1865 (M)
Chicago, Illinois 60661 sullivan@ls3ip.com

From: Rhett Barney
Date: Wednesday, September 9, 2015 at 4:44 PM
To: "Sean M. Sullivan"
Cc: Chris Lynch, Amanda Sasser
Subject: Clariant Opposition Proceeding No. 91223528 (DESIPAX)

Dear Mr. Sullivan,

I am one of the attorneys for Multisorb, Inc., and I'd like to briefly discuss with you the Opposition that was recently filed against our DESIPAX application. Do you have some time on Friday or Monday?

I look forward to hearing from you.

Best regards,
Rhett

Rhett Barney

rhettb@leehayes.com

P 509.944.4642 | **F** 509.323.8979

601 West Riverside Avenue, Suite 1400 | Spokane, Washington 99201

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<mime-attachment>

EXHIBIT B



Lee Sullivan Shea & Smith LLP

224 N Desplaines St
Suite 250
Chicago, Illinois 60661

312.754.9602
www.ls3ip.com

October 1, 2015

VIA E-MAIL

Rhett Barney
Lee & Hayes, PLLC
601 W Riverside Ave
Suite 1400
Spokane, Washington 99201

**Re: *Clariant Corporation v. Multisorb Technologies, Inc.*
*Opposition No. 91223528 for DESIPAX (Serial No. 86/569,259)***

Dear Rhett:

I write as a follow up to our telephone conversation on September 11, 2015 regarding the above-identified trademark opposition. Clariant filed its trademark application for DESI PAK on February 14, 1985, and has continuously used the DESI PAK mark since December 13, 1983. Evidence of such use can be found in Clariant's Affidavit of Continued Use and Incontestability under Sections 8 and 15 filed in 1991, as well as Clariant's Affidavit of Continued Use and Application for Renewal under Sections 8 and 9 filed in 2005. Since 2005, Clariant has also continued to use the DESI PAK mark as evidenced by, for example, the attached webpages from Clariant's (and its predecessor Süd-Chemie's) website. These webpages show continuous use of the DESI PAK mark for each year from 2005 to the present.

Please confirm that Multisorb will abandon with prejudice its trademark application for DESIPAX, Serial No. 86/569,259, and that Multisorb will cease and desist any and all use of the DESIPAX mark.

Best regards,

A handwritten signature in black ink, appearing to read 'S. Sullivan', followed by a long horizontal line.

Sean M. Sullivan
312 754 9607 direct
sullivan@ls3ip.com

Enclosures

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SÜD-CHEMIE
Creating Performance Technology

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Süd-Chemie Group > Products & Solutions > Performance Packaging

Süd-Chemie Performance Packaging - Desiccants, Absorbents, Humidity Indicators, and Polymer Solutions

We offer a wide range of Packaging Solutions to meet your needs

Süd-Chemie Performance Packaging offers a complete range of packaging solutions and customization capability to ensure that product quality is protected while brand identity and value are enhanced.

One of the worlds leading supplier of **desiccants, absorbents, humidity indicators, and polymer solutions**. Süd-Chemie Performance Packaging's products protect pharmaceutical, nutraceutical, diagnostics, electronic, food, chemical, automotive, and many other products from damage during shipping or storage.

Let us find a solution for you! Choose to view solutions by Industry or Products by selecting from below, or the highlighted list to the right (to remain within the Süd-Chemie Performance Packaging section of this site select from the highlighted areas to the right).

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- Ceramics
- Floor Absorbents
- Chemicals
- Petrochemicals
- Refinery
- Zeolite Powders
- Fuel-Cell
- Emission Control & Air Purification
- Water & Process Technologies
- Battery Materials



Desiccant Canisters are the preferred absorbent protection in the pharmaceutical industry due to their cylindrical shape and ability to be inserted at speeds of 500 plus per minute. [Learn more....](#)

Desiccant Packets are available for those who prefer, or already have existing machinery for packets. [Learn more....](#)

Container Dri® II eliminates mold, corrosion, mildew, peeling labels, and other harmful effects of moisture related damage during shipping and storage without generating liquid water.

To protect your cargo from moisture damage, you can request information and a free sample of Container Dri® II by clicking [here](#).

Latest news from Süd-Chemie Performance Packaging:

[Süd-Chemie launches desiccant washer for pharmaceutical applications](#)
February 21, 2005

[New Desi Blanket™ Offers High-Capacity Absorption in thin, adjustable shape, size](#)
January 3, 2005

[Süd-Chemie Expands Presence in China's Growing Pharmaceutical & Diagnostic Markets](#)
December 2, 2004


[Süd-Chemie Launches "Desi" Program to Help Manufacturers Increase Efficiency & Profitability](#)
October 26, 2004

For printable or e-mailable information, download our e-brochures:

[English](#) (PDF, 639 KB)
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Container Dri® II
Desi Fridge®
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Petrochemicals
Refinery
Zeolite Powders
Fuel-Cell
Air Purification
Water and Process Technologies
Waste Water Treatment and Plant Engineering
Battery Materials
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<input type="text" value="Company Finder"/>

Desiccant Bags

Protect goods within a sealed moisture barrier package or container from moisture damage

Applications: Electronic Components, Semiconductors, Machine Parts, Military Instruments & Armaments, Automotive Parts, Circuit Boards, Granulars (Flour, Sugar), Optical Devices & More

What are they?

Desiccant bags absorb moisture, odors and chemicals to preserve and protect any number of products, including semiconductors, electronics, cartons of food or even large machinery.

Why use them?

Whether in storage or transit, products in nearly every industry require protection from moisture. Rust, mildew, mold and an overall decrease in product efficacy are all common effects of moisture, costing millions in returned or unusable product each year. Desiccant bags help prevent damage by absorbing moisture in the air.

Available configurations

Süd-Chemie's desiccant bags are packaged in DuPont Tyvek®, GDT-II or high-strength polyester rayon materials, all of which are strong, durable and meet FDA specifications.

Bags are available in sizes ranging from 1/6 unit to 80 units (5 ½ grams to 2,640 grams). Desi Pak, a bentonite clay desiccant, is one of Süd-Chemie's most economical and effective options. Other fills include Sorb-It® (silica gel), Tri-Sorb® (molecular sieve), 2-in-1 Pak (silica gel or bentonite clay with activated carbon) and Getter Pak (activated carbon).

Süd-Chemie's full desiccant bags line includes:

Desi View® Indicating desiccant bags

With one side of clear film and a blue indicating gel fill, Desi View allows users to easily determine whether the desiccant has achieved its moisture vapor capacity.

Netted desiccant bags

Covered with a red, food-grade netting, the netted desiccant bags can be dropped directly into powdered products and easily identified and discarded once the product is ready to be used.

String-sewn desiccant bags

String sewn bags are ideal for protecting large items from rust, corrosion or other moisture damage. They can be hung on large equipment for transport or storage, or within storage or transport containers.

Süd-Chemie's desiccant bags comply with a wide range of industry standards, including military, aerospace, semiconductors, pharmaceuticals and more. For complete details, click on the Desiccant Bags product profile at right.

Süd-Chemie's adjustable desiccant blanket, **DESI BLANKET™**, as well as its patented shipping container desiccant, **Container Dri® II**, offer additional options for protecting products from moisture during shipping and storage. Click names for more information.

Absorbent Products:

Desi Pak®: Bentonite clay

Sorb-It®: Silica gel

Tri-Sorb®: Molecular Sieve

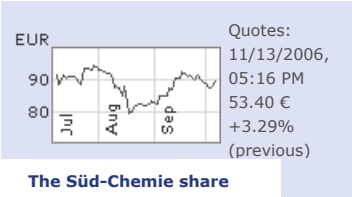
Getter Pak®: Activated carbon

2-in-1 Pak®: Silica gel or bentonite clay with activated carbon

Desi View®: Bentonite clay or silica gel with indicating gel



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Applications: Electronic Components, Semiconductors, Machine Parts, Military Instruments & Armaments, Automotive Parts, Circuit Boards, Granulars (Flour, Sugar), Optical Devices & More

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Tri-Sorb®: Molecular Sieve

Getter Pak®: Activated carbon


2-in-1 Pak®: Silica gel or bentonite clay with activated carbon

Desi View®: Bentonite clay or silica gel with indicating gel



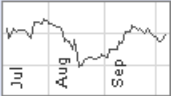
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Desi View®: Bentonite clay or silica gel with indicating gel



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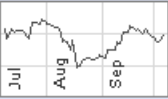


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Desiccant Bags

Protect goods within a sealed moisture barrier package or container from moisture damage

Applications: Electronic Components, Semiconductors, Machine Parts, Military Instruments & Armaments, Automotive Parts, Circuit Boards, Granulars (Flour, Sugar), Optical Devices & More

What are they?

Desiccant bags absorb moisture, odors and chemicals to preserve and protect any number of products, including semiconductors, electronics, cartons of food or even large machinery.

Why use them?

Whether in storage or transit, products in nearly every industry require protection from moisture. Rust, mildew, mold and an overall decrease in product efficacy are all common effects of moisture, costing millions in returned or unusable product each year. Desiccant bags help prevent damage by absorbing moisture in the air.

Available configurations

Süd-Chemie's desiccant bags are packaged in DuPont Tyvek®, GDT-II or high-strength polyester rayon materials, all of which are strong, durable and meet FDA specifications.

Bags are available in sizes ranging from 1/6 unit to 80 units (5 ½ grams to 2,640 grams). Desi Pak, a bentonite clay desiccant, is one of Süd-Chemie's most economical and effective options. Other fills include Sorb-It® (silica gel), Tri-Sorb® (molecular sieve), 2-in-1 Pak (silica gel or bentonite clay with activated carbon) and Getter Pak (activated carbon).

Süd-Chemie's full desiccant bags line includes:

Desi View® Indicating desiccant bags

With one side of clear film and a blue indicating gel fill, Desi View allows users to easily determine whether the desiccant has achieved its moisture vapor capacity.

Netted desiccant bags

Covered with a red, food-grade netting, the netted desiccant bags can be dropped directly into powdered products and easily identified and discarded once the product is ready to be used.

String-sewn desiccant bags

String sewn bags are ideal for protecting large items from rust, corrosion or other moisture damage. They can be hung on large equipment for transport or storage, or within storage or transport containers.

Süd-Chemie's desiccant bags comply with a wide range of industry standards, including military, aerospace, semiconductors, pharmaceuticals and more. For complete details, click on the Desiccant Bags product profile at right.

Süd-Chemie's patented shipping container desiccant, **Container Dri® II**, offers additional options for protecting products from moisture during shipping and storage.

Absorbent Products:

Desi Pak®: Bentonite clay

Sorb-It®: Silica gel

Tri-Sorb®: Molecular Sieve

Getter Pak®: Activated carbon

2-in-1 Pak®: Silica gel or bentonite clay with activated carbon

Desi View®: Bentonite clay or silica gel with indicating gel



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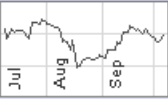


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Water and Process Technologies

Waste Water Treatment and Plant Engineering

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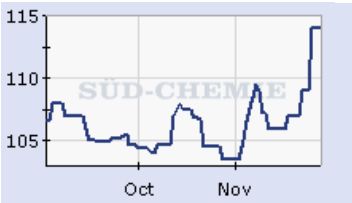
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▶ Washers

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▶ Tablets & Preforms

▶ Desiccant Packets

▶ Desiccant Bags

▶ Desi-Sheet™

▶ Cargo & Device Protection

Desiccant Packets



Süd-Chemie's desiccant packets protect products in a wide range of industries, including pharmaceuticals, nutraceuticals, medical, diagnostics, food, confectionary and electronics.

Packets are small sachets of bentonite clay, silica gel, molecular sieve or other absorbent products aimed at protecting goods from moisture, odors and other harmful elements. Packets are available in singles, or in our Continu-Strip® reels designed for automatic insertion.

Continu-Strip desiccant packets feature a hole punched in between every seal to avoid mis-cuts during automatic insertion.

Download Center: Desiccant Packets

Product Profile

 Desiccant Packtes 409kB

Product Catalog

 Desiccant Packets 382kB

PERFORMANCE PACKAGING DIVISION

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Product Sheet

DESICCANT PACKETS



DROP-IN AUTOMATABLE DESICCANTS



Purpose

Desiccant packets protect products in a wide range of industries, including pharmaceuticals, nutraceuticals and diagnostics from moisture damage.

What are they?

Desiccant packets are small sachets that can be filled with a variety of sorbent materials and are aimed at protecting goods sensitive to moisture.

Why use them?

Water, via hydrolytic degradation, is a major pathway for destabilization of many active pharmaceutical ingredients, shortening shelf life and efficacy. Furthermore, moisture can also degrade nutritional products as well as sensitive enzymatic reagents in diagnostic devices. Desiccant packets help prevent moisture damage by adsorbing free water within package headspace as well as any moisture that gains ingress via Moisture Vapor Transmission. Desiccant packets provide a simple, dependable and economical solution for preventing moisture damage in small, sealed packages.

Available Configurations

Clariant manufactures a wide range of packets in strip and single form ranging from 0.25g to 10g. Standard and customized sizes are available.

Continu-Strip® Hole Punch Packets are wound on a reel for automatic insertion and feature a hole in each seal. The hole is the most effective way insertion equipment can detect the cut location, ensuring accurate cutting and insertion into pharmaceutical containers. Unlike other desiccant packets that are marketed to be used on specific insertion machines, Continu-Strip packets from Clariant are versatile and can be used with any packet insertion equipment on the market with minimal modifications.

Packets are produced using industry leading nonwoven materials such as DuPont Tyvek®. Desiccant packets are compliant with US FDA regulations for contact with food & drugs.

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– BL Medical Specialties

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Sorbent Types

Clariant Brand	Sorbent Type
Desi Pak®:	Bentonite (moisture adsorption)
Sorb-It®:	Silica gel (moisture adsorption)
Tri-Sorb®:	Molecular sieve (moisture adsorption)
Getter Pak®:	Activated carbon (odor control)
2-in-1 Pak®:	Desiccant + activated carbon (moisture and odor control)

Key Advantages

- Desiccant packets are available in a variety of sizes and desiccant types to meet the needs of diverse applications.
- Continu-Strip® packets are available for automated packaging lines.
- A hole is punched in every seal provides—a reliable method for avoiding mis-cuts.



Clariant's packets are available in single form or Continu-Strip® for automated insertion.

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Clariant’s desiccant packets protect products in a wide range of industries, including pharmaceuticals, nutraceuticals, medical, and diagnostics.

Packets are small sachets of bentonite clay, silica gel, molecular sieve or other absorbent products aimed at protecting goods from moisture, odors and other harmful elements. Packets are available in singles or in our Continu-Strip® reels designed for automatic insertion.

Continu-Strip desiccant packets feature a hole punched in between every seal to avoid mis-cuts during automatic insertion.



DESICCANT BAGS

SILICA GEL AND BENTONITE CLAY DESICCANT BAGS

Edition Date : August 14, 2015



Clariant manufactures a full line of moisture adsorbent bags which consist of strong, yet porous, nonwoven materials such as Dupont Tyvek®, filled with a variety of desiccant types:

Desi-Pak® - bentonite clay

Sorb-It® - silica gel

Tri-Sorb® - molecular sieve

Used to protect a variety of goods as they travel through the supply chain, our bags comply with rigorous industry and government standards including FDA, DIN, Mil-Spec, and JEDEC.

Commonly used for semiconductor dry packing, preservation packaging and export packaging, with typical applications including electronic devices, food, equipment, automotive parts, machinery, military goods, metal components and many other valuables.

For the protection of bulk pharmaceutical packaging, Clariant's Healthcare Packaging business line offers desiccant bags for pharmaceutical applications.

For more information about our desiccant, oxygen absorber, and humidity indicator solutions, visit our [Cargo & Device Protection](#) page.

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Ryan Grauer

Contact Person

BENEFITS

Desiccant bags effectively adsorb moisture in product packaging to combat its damaging effects including corrosion, mold and degradation.

Desiccant bags meet Mil-D-3464E (Mil Spec) Types I, II and III, as well as comply with JEDEC for semiconductor packaging.

Single bags as standard according to DIN / AFNOR / MIL

SAFETY AND MSDS

Contact Us

Please contact us for safety and regulatory details or the Material Safety Data Sheet (MSDS).

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DESI_PAK_DESICCANT_BAGS_EUROPEAN_PROGRAM

DESI_PAK_TROCKENBEUTEL_DE_EUROPEAN_PROGRAM

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